

REMARKS

Applicants respectfully request that the above amendments be entered for purposes of the present application. Claims 1 to 7 are presented for consideration. Claims 1 to 5 and 7 have been amended to more distinctly claim the Applicant's invention. The specification was amended to overcome the Examiner's objections to the preliminary amendment.

35 U.S.C. §112 Rejections

Claims 1-7 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1-5 and 7 were amended to more clearly claim the Applicant's invention and to overcome the rejection. However, the rejection of claim 1 for use of the term "substantially continuous" is respectfully traversed. It is clear to those skilled in the art that the term "substantially continuous" is used to include materials that are not perfectly continuous, but rather are somewhat porous. Accordingly, it is respectfully requested that the rejection of claims 1-7 under 35 U.S.C. §112, second paragraph, be withdrawn.

35 U.S.C. §103(a) Rejections

Claims 1-7 stand rejected under 35 U.S.C. §103(a) as obvious over Martin (4,859,183) in view of Ruddle (6,179,617). The rejection is respectfully traversed.

Briefly, Applicant's invention, as claimed in amended claim 1, is a root canal instrument with a metallic needle part and a gripping end attached to the upper end of the needle part to serve as a handle. The outer surface of the gripping end is substantially continuous such that the coefficient of friction of

at least the material used in the outer surface of the gripping end is higher than the coefficient of friction of metal and polyphenylene sulphide which have typically been used in gripping ends of root canal instruments. Additionally, the hardness of at least the material used in the outer surface of the gripping end as well as the thickness of this material layer are chosen so that the shape of the gripping end is recoverably deformable between fingers.

Neither Martin nor Ruddle disclose all the elements of independent claim 1. As noted in the outstanding Office Action, Martin does not disclose a substantially continuous handle. However, Martin and Ruddle also fail to disclose that the outer surface of the gripping end is substantially continuous such that the coefficient of friction of at least the material used in the outer surface of the gripping end is higher than the coefficient of friction of metal and polyphenylene sulphide which have typically been used in gripping ends of root canal instruments. Furthermore, Martin and Ruddle do not teach that the hardness of at least the material used in the outer surface of the gripping end as well as the thickness of this material layer are chosen so that the shape of the gripping end is recoverably deformable between fingers.

The mere reference to silicone in Martin is not enough to teach these elements. There are many types of silicone. Many silicones do not have the properties claimed in independent claim 1. Therefore, the reference to silicone alone is not enough to disclose these features. The example of silicone rubber in the present application is referring to a silicone rubber with the properties claimed in independent claim 1.

Assuming, *arguendo*, that the references disclose the elements as described in the outstanding Office Action, no motivation exists to combine the teachings of Martin and Ruddle. The instruments

of Martin and Ruddle are very distinct, and are used for in different way for different purposes.

Ruddle discusses microbrushes and not needles. Furthermore, the entire purpose of Martin would be frustrated by combining it with the continuous handle purportedly taught by Ruddle. The focus of Martin is the non-continuous gripping end. To replace the gripping end of Martin with a continuous handle is to totally disregard the teachings of Martin. Accordingly, there is no motivation to combine these two references in the manner cited by the Examiner.

Accordingly, for at least the reasons discussed above, neither Martin nor Ruddle, either alone or in combination, disclose all the features of the claimed invention. Therefore it is respectfully requested that the Examiner withdraw the rejection of independent claim 1. Furthermore, by reason of their dependence from claim 1, it is respectfully requested that the Examiner withdraw the obviousness rejection of claims 2-7.

Conclusion

In view of the amendments to claims 1-5 and 7 made herein and the arguments presented above, it is submitted that the Examiner's rejections have been overcome and should be withdrawn. The application should now be in condition for allowance.

The Applicants note that there is no indication that the drawings are acceptable. The Applicants respectfully request that the Examiner provide indication that the drawings are accepted by the Examiner in the next formal communication.

Should any changes to the claims and/or specification be deemed necessary to place the application in condition for allowance, the Examiner is respectfully requested to contact the

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undersigned to discuss the same.

This Response is being timely filed. In the event that any other extensions and/or fees are required for the entry of this Amendment, the Patent and Trademark Office is specifically authorized to charge such fee to Deposit Account No. 50-0518 in the name of Steinberg & Raskin, P.C. An early and favorable action on the merits is earnestly solicited.

Respectfully submitted,
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